

## REMARKS

By way of the present response, claims 1, 8, 15, 16, 19-21, 27-30 and 33 are amended with claims 1, 8 and 15 being independent. Claims 1, 2, 5-9, 12-16, 19-21 and 25-33 currently are pending.

The office action includes a rejection of claims 1, 2, 5-9, 12-16, 19-21 and 25-33 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement asserting the term “self-contained” is not found in the specification. Accordingly, Applicant has amended claims 1, 8 and 15 to cancel “self-contained” and recite “a plurality of parts being connectively contained within the apparatus” as set forth above. Support for these amendments can be found at least in FIG. 1 at 12, 14(1)-14(3) and 16(1)-16(3) and paragraphs [0012] to [0014] in the above-identified patent application. In view of the foregoing amendments and remarks, Applicant respectfully requests the Office to reconsider and withdraw this rejection.

The Office has rejected claims 1, 2, 5-9, 12-16, 19-21 and 28-33 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,486,769 to McLean (McLean), claims 28, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over McLean, in view of U.S. Patent No. 5,398,257 to Groenteman (Groenteman), and claims 31, 32 and 33 under 35 U.S.C. §103(a) as being unpatentable over McLean, in view of Groenteman, and further in view of U.S. Patent No. 6,494,370 to Sanchez (Sanchez).

With respect to independent claims 1, 8 and 15, the Office asserts McLean discloses (col. 5, line 51- col. 6, line 4) RFID checktag A (there are a plurality of checktags in the system) with memory 168, and control logic 166. The Office also asserts McLean discloses a radio frequency communication system (Abstract) with a controller adapted to send and received data from two subsets of a plurality of transponders (checktags). Additionally, the Office asserts control logic 166 accesses the memory 168 to read and for write data therefrom. Further, the Office asserts col. 5, line 55, in McLean discloses the control logic 166 controls the functions of the RFID checktag A 160 in response to commands provided by the Base station 120 (interrogating). The Office asserts col. 6, lines 5-67 in McLean disclose a series of queries and checks of a plurality of checktags, receiving information and providing optimization settings. Additionally, the Office notes col. 6, lines

64-67 in McLean applies generally to any communication system where a base unit communicates with one or more transponders, *e.g.*, tags.”

However, amended claims 1 and 8 recite, *inter alia*, the features of “interrogating one part of a plurality of parts being connectively contained within the apparatus, each of said parts including a respective information component comprising memory and a processor,” and similar concepts are recited in the context of the apparatus in amended claim 15.

The claimed subject matter operates to gather information from one or more parts of a plurality of parts being connectively contained within an apparatus and is directed to optimizing performance of at least one operation performed by the apparatus including mechanisms for optimizing performance of at least one operation performed by the apparatus. For instance, as shown in FIG. 1 and described in paragraphs [0008] to [0009] of the published patent application, an apparatus may include a plurality of parts connectively contained within the apparatus (see FIG. 1 at 12 and 14(1) to 14(3)). Each of the plurality of parts includes an information component (*e.g.*, items 16(1) to 16(3)), which in turn, includes memory (*e.g.*, 22(1)-22(3)) and a processor (*e.g.*, (20(1)-20(3)) (see, paragraph [0008] of published patent application). The claimed subject matter makes it possible to interrogate any of the parts determined needed for the operation being optimized, and to obtain information stored in the memories about those parts (see, paragraphs [0014] and [0015] of the published patent application, and original claims 3, 4, 10, 11, 17 and 18).

It is respectfully submitted that McLean does not teach or disclose the feature of interrogating one part of a plurality of parts being connectively contained within the apparatus, each of said parts including a respective information component comprising memory and a processor, as presently claimed. While McLean is concerned with a method and system for automatically adjusting a radio frequency communication system, it is directly to an entirely different device and operation. Specifically, McLean describes an RFID checktag A system with a memory and control logic. McLean further describes a radio frequency communication system including a controller adapted to send and received data from two subsets of a plurality of transponders (checktags). The control logic accesses the memory to read and for write data therefrom. (See col. 5: 55). However, McLean does not

teach or disclose the claimed features relating to a plurality of parts being connectively contained within the apparatus, each of said parts including a respective information component comprising memory and a processor. In contrast, FIGS. 2 and 3 of McLean appear to show only one memory and processor in apparatus 120 and only one memory and control logic in a separate apparatus 160. Therefore, Applicant contends that McLean fails to teach or disclose the features of a plurality of parts being connectively contained within the apparatus, each of said parts including a respective information component comprising memory and a processor, as claimed. Thus, it cannot be said that McLean anticipates the features of a plurality of parts being connectively contained within the apparatus, each of said parts including a respective information component comprising memory and a processor, as presently claimed.

With respect to the rejection of claims 28, 29 and 30 under 35 U.S.C. §103(a) as allegedly being unpatentable over McLean, in view of Groenteman, it is respectfully submitted that the Groenteman patent, which is relied upon for describing a copy machine and a processor that gathers and generates status information and transmits using a wireless transceiver, does not remedy the shortcomings pointed out above with respect to McLean. Rather, Groenteman appears to describe a printer device including only one processor for gathering and generating status information about the device (see, column 2, lines 25-27) from sensor or information ports within the copying circuitry (see, column 2, lines 42-44), and Groenteman does not otherwise mention details of the parts of the device. Further, it is unclear to the Applicant as to the motivation to combine the McLean and Groenteman references given the Office's reasoning:

“Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify the **“printer device” (Such, [0063])**, to include a copy feature, as disclosed by Groenteman, because it is old and well known that a copy feature is commonly combined with printers, and the combination is obvious to make the printing device more useful.” (emphasis added)

It appears that the Office has relied upon an unrelated motivation from a previous office action in error. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated the cited prior art, whether taken alone or in combination, discloses or suggests each and every feature recited in the claims. See M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not

shown the existence of any reasonable probability of success in modifying the base reference, based on the teachings the secondary references, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied reference or in the knowledge generally available to one of ordinary skill in the art, to modify the cited prior art in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicant's own disclosure. *See id.*

Sanchez does not cure the deficiencies of McLean and Groenteman as mentioned above. Therefore, Applicant notes that independent claims 1, 8 and 15 are allowable as discussed previously. Any claim that depends from an allowable claim is allowable as well. Thus, Applicant respectfully requests that the rejection to dependent claims 2, 5-7, 9, 12-14, 16, 19-21 and 25-33 be removed.

The methods and apparatus of present invention facilitate use of “smart” parts in an apparatus, for example, use of parts having relaxed and/or changing tolerances, wherein such characteristics are stored in memory of information components of the parts. By accessing and receiving the information stored in the part through interrogation of the parts, instructions can be determined and transmitted to the parts to optimize one or more operations of the apparatus without sacrificing performance of the apparatus. It is respectfully submitted that the methods and apparatus of McLean and Groenteman do not suggest any such methods and mechanisms for receiving information from an information component of a part and implementing instructions at the information component of the part.

Claims 2, 5-7, 9, 12-14, 16, 19-21 and 25-30 depend from one of claims 1, 8 and 15, and are therefore allowable at least for the above reasons, and further for the additional features recited.

In view of all of the foregoing, Applicant requests withdrawal of the rejections of the claims and allowance of this application. Prompt notification of the same is earnestly solicited.

Respectfully submitted,

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